

In re Goecke

Ser No.: 10/674,108, Filed: 9/29/03

Docket No.: 29006-2

Amendment A and Response to Office Action Dated October 18, 2005

## REMARKS

Applicant wishes to thank the Examiner for the consideration given this case to date.

Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application, as amended, is now in condition for allowance. Claims 1-7 and 9-12 remain pending.

## THE EXAMINER'S ACTION

In the Office Action dated October 18, 2005, the Office:

- 1) withdrew the rejections in the previous Office Action; and
- 2) rejected claims 1-6 and 9-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S.

Patent No. 5,839,977 to Maurer ("Maurer").

## PROCEDURAL MATTERS

There is an inconsistency in the posture of the present application. In the Office Action Summary, the Office lists claims 1-7 and 9-12 as being rejected. However, in the Detailed Action, only claims 1-6 and 9-12 are addressed. Thus, the allowability of pending claim 7 may have been overlooked by the Office. In order to be completely responsive however, Applicant will here treat all pending claims (1-7 and 9-12) as being rejected and will present remarks relating to the appropriateness of such a rejection in light of the record and references.

Additionally, Applicant requests an acknowledgment that the Drawing filed with the application on September 23, 2003 is acceptable.

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**REJECTIONS UNDER 35 U.S.C. § 103(a)**

**Claims 1-7 and 9-12 are not obvious in light of Maurer alone**

As understood, Maurer relates to tape intended for application to hockey sticks. In an illustrated embodiment, an appliqué is shown containing “steps” that are thought to provide directional control of a hockey puck following contact with the stick blade (see generally, Figure 14 and discussion starting at column 12, line 42 bridging to column 13, line 18). To achieve this directional control, Maurer discloses a stepped configuration where the thickness of the appliqué increases at each step by 0.020”.

As amended, Claim 1 calls for a polymer layer having a Shore A Hardness of between about 92 and 100 and a substantially uniform thickness of between about 0.020” to 0.065”.

The Office admits that Maurer “fails to teach ... hardness ranges between 92 and 100” and a thickness “between 0.020 and 0.065 inches” (Office Action, middle of page 3). The Office attempts to rectify this failure by suggesting that Maurer teaches a thickness contained in the claimed range, namely 0.048 inches.

The Office relies on a passage in Maurer discussing the stepped tape configuration. The “step” presumably includes both the tape substrate and adhesive layers. (column 12, lines 66 and 67). The passage describes a first step having a thickness of 0.008 inches, a second step having a thickness of 0.028 inches and a third step having a thickness of about 0.048 inches.

Recalling that the claim recites a polymer layer having a substantially uniform thickness between 0.020” to 0.065”, it is now apparent that Maurer does not meet the limitation. Instead, Maurer recites a tape including abruptly increasing thicknesses in order to provide directional

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control over a puck hitting a hockey stick. For this reason alone, Maurer fails to teach or render obvious Claim 1, or Claims 2-7, 9 and 10 depending therefrom.

Claim 7 calls for the adhesive to comprise a rubberized double-sided tape. The Office concludes summarily that Maurer discloses a double-sided tape. As a threshold matter, the Office does not assert and nowhere in Maurer is there a teaching of any rubberized tape. For this reason alone the rejection should be withdrawn because Maurer does not disclose each and every element of the claim.

Secondly, the Office's conclusory assessment that Maurer discloses a double-sided tape merely because it adheres to layers on opposing sides is overbroad. Specifically, were this assertion to be meritorious, it would require that other clearly non-tape products such as glues, epoxies, and even used chewing gum to be considered "double-sided tape" merely because they adhere on opposing sides. Since the Office stretches the definition of "tape" beyond any conventional meaning, the rejection should be withdrawn.

Thus, for the reasons above, Maurer fails to teach or render obvious Claim 7, and the rejection should be withdrawn.

Claim 10 calls for the adhesive to be pressure sensitive. The Office, confronted with the lack of any such teaching in Maurer, accepts the ready expedient of declaring that such an element would be obvious. The rationale supplied by the Office – that a pressure sensitive adhesive is obvious merely because Maurer's disclosed adhesive is protected by a release liner – is unconvincing. Applicant discovered no teaching that a release liner would suggest a pressure sensitive adhesive to an artisan. Should the Office maintain this rejection, Applicant requests a

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specific citation to the portion of the reference relied upon in support of the combination suggested.

Claim 11 calls for, among others, a pressure sensitive adhesive. For reasons set forth above, this rejection is improper and should be withdrawn.

Claim 11 further calls for an average thickness of 65 – 69 mils. First, it is noteworthy that Maurer discloses, at maximum, part of a tape with a thickness of 48 mils. Thus, at best, the reference not only fails to teach anything actually in the claimed range, but misses by a margin of 40%. Were Maurer's average thickness used, as claimed, it would miss by a margin of 145%.

Second, the Office asserts that the motivation to dramatically increase the thickness is for "optimizing adhesivability" of the tape. This is contrived. Merely increasing tape thickness does not necessarily correlate into increased adhesiveness. Conversely, decreasing tape thickness does not necessarily correlate into decreased adhesion. More than thickness of the tape, adhesion is dependent on environmental conditions and properties of the adhesive in use.

Thus, for the reasons above, Maurer fails to teach or render obvious Claim 11, and the rejection should be withdrawn.

Claim 12 calls for, among others, a double sided adhesive layer. For reasons set forth above with respect to Claim 7, this rejection is improper and should be withdrawn.

Claim 12 additionally calls for a peel adhesion of greater than 2.0 lb/in. width. Maurer is completely silent on the matter of peel adhesion. In order to establish a prima facie case of obviousness, the Office must establish three basic criteria. First, there must be some suggestion

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or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP § 2143. If one criteria is unmet, the rejection is improper and should be withdrawn. Here Maurer fails on at least two counts.

First, Maurer fails to suggest the claimed limitation. Indeed, Maurer appears to suggest an adhesive "similar or identical" to that used on then current hockey tapes (Column 9, lines 41-43). No information in the record reflects what this adhesion would be, while the experimental data obtained by Applicant shows a marked increase in adhesion over the comparison tape. The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. Since Maurer fails to suggest the modification proposed by the Office, Maurer fails to render obvious Claim 12.

Second, Maurer utterly fails to teach or suggest all the claim limitations. As noted, Maurer is completely silent on the matter of peel adhesion. As such, because Maurer fails to teach or suggest all the claim limitations, the rejection should be withdrawn

For the reasons above, Maurer fails to render obvious Claim 12, and the rejection should be withdrawn.

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## CONCLUSION

Applicant, intending to be completely responsive, believes that the amendments and remarks presented above resolve all outstanding issues on the above-referenced application. Accordingly, the application is believed to be in condition for allowance. Early notice thereof is earnestly solicited. While no additional fees are believed due, the Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Attorney Docket No. 29006-2.

Respectfully submitted,

Dated: January 12, 2006

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